

## **REMARKS**

### **Formal Matters**

Claims 61-82 were examined and stand rejected.

Claims 61-82 are pending after entry of the amendments set forth herein.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

Support for the amendments to claims 61, 68-69 and 81 can be found throughout the specification, at, for example, page 23, lines 14-18, and page 27, lines 16-30. As such, no new matter has been added.

### **Rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.**

Claims 68-69 and 81 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner asserts that claim 68 is vague and indefinite in the recitation of “the fragments” in step (a) of claim 61, upon which claim 68 is dependent. Applicants have amended the term “the fragments” in step (b) of claim 61 so that it refers to each of the two different fragments generated from the polynucleotide. Support for these amendments can be found throughout the specification, at, for example, page 23, lines 14-18, and page 27, lines 16-30. As such, no new matter is added. The Applicants submit that the rejections are overcome by this amendment and respectfully request that these rejections be withdrawn.

The Examiner also asserts that claims 69 and 81 are indefinite because “it is unclear whether the phrase [primers are comprised of] is open or closed claim language.” The Office Action suggests that amending the claim language to “comprised” or “consist of” would be remedial. Although Applicants contend that the phrase “primers are comprised of” is not indefinite and would be understood by one of ordinary skill in the art, Applicants have adopted Examiner’s suggestion and replaced the phrase with the term “comprise” in claims 69 and 81. Applicants submit that the rejection is overcome by this

amendment and respectfully request that this rejection be withdrawn.

Therefore, Applicants submit that rejection of the above-cited claims under 35 U.S.C. § 112, second paragraph, is overcome in view of the amendments and remarks set forth herein. The Examiner is thus respectfully requested to withdraw these rejections.

**Rejection under Non-Statutory Double Patenting.**

Claims 61-82 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting, as allegedly being unpatentable over claims 1-50 of copending Application No. 10/087,523.

The Office Action suggests that “a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome [the] . . . provisional rejection.” Although Applicants contend that the present application and cited Application No. 10/087,523 are patentably distinct from each other, Applicants have adopted the Examiner’s suggestion and have provided a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) and 37 C.F.R. § 3.73(b). Applicants submit that the rejection is overcome by this terminal disclaimer and respectfully request that this rejection be withdrawn.

Therefore, Applicants submit that rejection of the above-cited claims under the judicially created doctrine of obviousness-type double patenting, is overcome in view of the terminal disclaimer and remarks set forth herein. The Examiner is thus respectfully requested to withdraw these rejections.

**Conclusion.**

Applicants submit that all of the pending claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

Application No. 09/885,816  
Deltagen Docket No. MES-01-CON

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1271.

Respectfully submitted,  
DELTAGEN, INC.

Date: 5/30/2003

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